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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,176	02/09/2004	Shaun T. Mesher	355-8	6755
20212	7590	03/04/2009	EXAMINER	
Lambert Intellectual Property Law Suite 200 10328 - 81 Avenue Edmonton, AB T6E 1X2 CANADA			METZMAIER, DANIEL S	
ART UNIT	PAPER NUMBER			
1796				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/773,176	<b>Applicant(s)</b> MESHER ET AL.
	<b>Examiner</b> Daniel S. Metzmaier	<b>Art Unit</b> 1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 November 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,10,14,16,17 and 30-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 14,16 and 17 is/are allowed.
- 6) Claim(s) 1,10 and 30-36 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

#### **DETAILED ACTION**

Claims 1, 10, 14, 16-17, and 30-36 are pending.

##### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 10 and 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watkins, US 4,737,296.

Watkins (column 7, lines 33-36; column 8, lines 6-10, 26-32, 51-52, 66 to column 9, line 1; column 9, lines 45) discloses the formation of acid-containing foams for the purpose of cleaning scale out of conduits. Watkins (column 7, line 36) clearly contemplates mixtures of solvents.

Watkins (column 8, lines 6 et seq) clearly contemplates alcohols, esters and ketones as claimed.

Watkins differs from the claims in the use of a particular combination of solvents and the concentrations thereof.

Watkins (column 7, lines 33-36; column 8, lines 6-10, 26-32, 51-52, 66 to column 9, line 1) contemplates mixtures of solvents including those instantly claimed. Watkins (example 16) discloses the use of MEK at about 22 vol% and about 74 vol% acid. The vol% is referenced for simplicity and the wt% of the materials would not vary

dramatically therefrom since the materials would have been expected to have specific gravities of about 1.

It is generally *prima facie* obvious to use in combination two or more ingredients that have previously been used separately for the same purpose in order to form a third composition useful for that same purpose. *In re Kerkhoven*, 626 F.2d 846, 205 USPQ 1069 (CCPA 1980); *In re Pinten*, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971); *In re Crockett*, 279 F.2d 274, 126 USPQ 186 (CCPA 1960). As stated in *Kerkhoven* and *Crockett*, the idea of combining them flows logically from their having been individually taught in the prior art. In the instant case, the ester, ether, and alcohol solvents are all taught for the same function as a mutual solvent of the oil and water. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to employ the mixtures in an acid-containing composition for the advantage of matching the solvent system to the system, e.g., sludge and scale, being treated.

The specification does not provide a showing of criticality of the particular solvents and each is specifically recited in the Watkins reference.

***Allowable Subject Matter***

3. Claims 14 and 16-17 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action.

***Response to Arguments***

4. Applicant's arguments filed 07 November 2008 have been fully considered but they are not persuasive.

5. Applicants (pages 6 and 7) assert the amended claims requiring a "mutual solvent system comprising a solution" distinguish the claims from the Watkins reference. Applicants assert that defining the composition as a solution distinguishes the claims from the Watkins reference. This has not been deemed persuasive.

Initially, the term solution has not been specifically defined in the instant specification. Therefore the term takes the plain meaning in the art. Said definition would include the breadth of the term as would be understood by the skilled artisan and not a single definition of the term. Attention is directed Hawley's Condensed Chemical Dictionary definition of "solution, colloidal".

Furthermore, applicants do not exclude and would be interpreted as clearly contemplating materials that would form colloidal solutions by the characterization in paragraph [0001] of the **specification** that **teaches** a "mutual solvent of oil and water" and:

"A challenge in the art of acidizing wells is to provide a solvent system with a mutual solvent that is effective in cleaning wells and production equipment, while being economical and environmentally friendly."

Nowhere in the instant application is "mutual solvent system comprising a solution" taught or defined as a single phase solution.

6. Applicants (page 6) assert the claimed invention of claim 1 is not enabling in the disclosure of the Watkins reference. This has not been deemed persuasive and the basis therefore is set forth in the above rejection. Applicants' conclusion is based on a distinction that does not exist between solution as claimed and the disclosure of Watkins.

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7. Applicants' (page 6) assertion that the Watkins reference requires an emulsifier, thus forming a two phase composition has not been deemed persuasive. The claims do not exclude colloidal solutions. Furthermore, the instant (5 page) specification sets forth (paragraph 6): "The term 'comprising' is used in its inclusive sense, and does not exclude other components being present.", and (paragraph 13); "Immaterial modifications may be made to the invention described here, without departing from the invention as defined by the claims."

Clearly colloidal solutions have not been distinguished by the amendments to the claims and clearly applicants contemplate further ingredients, such as emulsifiers.

8. Applicants (page 6) assert the reference teaches away from the mutual solvent system solution. Applicants' arguments are not commensurate in scope with their claims and have not been deemed persuasive. Applicants are merely employing the disclosed solvents for their intended function as solvents.

Applicants' reference to unexpected results has not been deemed persuasive. Applicants' arguments are not commensurate in scope with the claims. "The arguments of counsel cannot take the place of evidence in the record." See MPEP 716.01(c). "Applicants must further show that the results were greater than those which would have been expected from the prior art to an unobvious extent, and that the results are of a significant, practical advantage. Ex parte The NutraSweet Co., 19 USPQ2d 1586 (Bd. Pat. App. & Inter. 1991)." See MPEP 716.02(a). It is suggested that applicants review all of section 716 of the MPEP for the requirements of unexpected results.

This has furthermore not been deemed persuasive since it is unclear what results applicants are relying that is asserted as unexpected since the combination of solvents have not been shown to be above the additive effect of the components, which are each taught as solvents.

9. Applicants (pages 6 and 7) assert the Watkins references are directed to making foams and not to mutual solvent solutions. This conclusion is based on the premise that solvent solutions would not be useful or expected to have a beneficial effect in the foams that are finally formed in the Watkins reference. This has not been deemed persuasive since clearly the Watkins reference is directed to acidized cleaning of the well, it would clearly have been desirable to solubilize the materials of oil and aqueous components for cleaning the well.

10. Applicants' (page 7) arguments that the Watkins reference discloses a large number of solvent has not been deemed persuasive since the solubility properties are known and characterized in the prior art and applicants' claims merely recite a generic class of solvents. Thus the selection of solvents is far less than alleged by applicants since numerous solvents read on applicants claimed genus.

11. Applicants' amendments are not deemed to distinguish the rejection, which has been maintained for the reasons as set forth above.

#### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David W. Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Daniel S. Metzmaier/  
Primary Examiner, Art Unit 1796

DSM